

REMARKS

Applicants acknowledge receipt of an Office Action with a mail date of May 26, 2010.

I. Status of the Claims

Claims 1-9 are pending and currently rejected. In this response, claim 1 is amended to change the term “comprising” to “consisting essentially of”.

After amending the claims as set forth above, claims 1-9 are pending in the application and remain under examination.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate status identifier.

Applicants respectfully request reconsideration of the present application in view of the reasons that follow.

II. Rejection of the Claims Under 35 U.S.C. § 103

A. Claims 1, 3-6 and 9

Claims 1, 3-6 and 9 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Tasaka *et al.*, JP 2002-322321 (“Tasaka”). Applicants respectfully traverse this ground for rejection.

According to the Office:

Tasaka et al. disclose an elastomer composition comprising 35 parts by weight of SBS, 45 parts by weight of ethylene-butene rubber, 17.5 parts by weight of oil, 17.5 parts by weight of paraffin, and 20 parts by weight of polypropylene (Example 6). The ratio of melt flow rates and molecular weight distribution are inherent properties.

Office Action, at pages 2-3.

The Office also states on page 3, lines 3-4, that “Tasaka et al. are silent on the specific amount of 1-butene in the ethylene/1-butene in the random copolymer.”

Applicants submit that Tasaka discloses a thermoplastic resin composition obtained by melting a composition comprising at least one elastomer component (a) selected from the group consisting of (a-1), (a-2) and (a-3) and the components (b) and (c).

Herein, Applicants submit that it is important to stress the following: (1) Tasaka makes it mandatory for the composition to contain the component (c), i.e., an organic peroxide. The resultant composition is always a crosslinked composition; and (2) Of the disclosures in Tasaka, only Examples 5 and 6 provide formulations relevant to the claimed formulation. The other disclosures in Tasaka do not provide any suggestion of the claimed specific composition.

In the Examples 5 and 6 of Tasaka, the following ethylene/butene copolymer (EBR) is used: ethylene/butene copolymer EBR ESPRENE N0441 (Sumitomo Chemical Co., Ltd.). However, Tasaka’s disclosure provides no indication of the properties of ESPRENE N0441. Applicants, therefore, find it difficult to know whether ESPRENE N0441 satisfies the requirements recited in claim 1. Nonetheless, Applicants have searched JP documents and have arrived at JP-A-2003-176385, owned by Riken Technos Corp., which owns the cited application. In JP-A-2003-176385, the following information on ESPRENE N0441 is provided: MFR is 1.3 g/10 min (190°C), butene content: 30% (unclear whether the unit is % by mole or % by weight) and Mooney viscosity (ML₁₊₄, 100°C): 25. Applicants submit that because there is no other information on ESPRENE N0441, it is impossible to compare ESPRENE N0441 with the component (a) of the presently claimed invention.

The lack of a complete comparison of properties notwithstanding, Applicants submit that in Tasaka’s Examples 5 and 6, an organic peroxide is used and the resultant composition is a crosslinked product. In contrast, the claimed composition is not a crosslinked product. Accordingly, the presently claimed invention is distinguished from Tasaka, which requires crosslinking.

Further, the compositions of the Examples 5 and 6 contain an excessive amount of calcium carbonate. Additionally, if the tensile strength (TS) and shore A hardness of the compositions of Tasaka's Examples 5 and 6 are measured, as in the case with the claimed compositions, it is expected that: the tensile strength of Examples 5 and 6 will much exceed the values of Examples 1 through 6 corresponding to the presently claimed invention, i.e., 5 through 9 MPa (an indication in accordance with JIS K 7113); and the shore A hardness of Tasaka's Examples 5 and 6 will much exceed the values of Examples 1 through 6 corresponding to the presently claimed invention. This is because the Tasaka's compositions are crosslinked products and contain an excessive amount of calcium carbonate.

In view of this, the compositions of Tasaka's Examples 5 and 6 have properties totally different from those of the presently claimed invention, which provides an article with flexibility, strength and less-oil bleed-out achieved in fine balance.

Applicants note the following statement appearing in line 16, page 15 of the present specification:

The resin composition of the invention may contain, if necessary, other synthetic resins or rubbers, or additives such as an antioxidant, a thermal-resistant stabilizer, a weather-resistant stabilizer, a slipping agent, an anti-blocking agent, a crystal nucleating agent, a pigment, and a hydrochloric acid absorbent, within the scope of impairing the performance of the resin composition.

As evidenced from the above disclosure, the presently claimed invention allows the composition to contain other components but does not allow the impairing of the composition because of these other components.

Applicants also note that the crosslinking agent, such as the "organic peroxide," will impair the object of the invention. The claimed composition, therefore, does not contain the crosslinking agent such as "the organic peroxide". It is obvious that the organic peroxide will alter the properties of the claimed composition and adversely affects the object of the

invention.

Accordingly, based on the selected passage of the present specification discussed above, one should infer that although the claimed composition will allow the co-presence of components such as stabilizers and pigments therein, the crosslinking agent such as the “organic peroxide”, which will affect and alter the properties of the claimed composition, are eliminated. To clarify, Applicants have amended the phrase “comprising” in claim 1 to the phrase “consisting essentially of”.

For at least the reasons set forth above, Applicants submit that the presently claimed invention is distinguished from Tasaka

Additionally, for Tasaka’s Examples 5 and 6, an inorganic filler, i.e., CaCO_3 , is contained in an amount excessive enough to impair the object of the invention. Applicants submit, however, that a similar reasoning as provided above with respect to “organic peroxide,” can be applied to the “inorganic filler”. That is, the selected passage of the present specification discussed above indicates that resins and inorganic fillers in an amount excessive enough to impair the object of the invention are eliminated. For this reason as well, the presently claimed invention is distinguished from Tasaka.

Applicants stress that the presently claimed invention is sufficiently distinguished from Tasaka for the reasons set forth above, with respect to arguments directed to the crosslinking agent, which also includes the “organic peroxide.” Therefore, the additional arguments presented above, with regard to the inorganic filler, are submitted to assist the Office in understanding the differences between the claimed invention and the cited reference.

As described hereinabove, although the compositions of Tasaka’s Examples 5 and 6 contain the claimed components, the compositions contain other significant components. The other significant components include the “organic peroxide”. However, as discussed above, with this formulation, the object of the invention cannot be attained.

In addition, there is no description or suggestion in Tasaka to select the claimed components from Examples 5 and 6 in order to arrive at the claimed compositions. Thus, Applicants submit that it would not have been easy for a skilled person to expect that the selection of combination of claimed components alone would provide the advantageous effects of the presently claimed invention. Consequently, Applicants submit that the Office has inadvertently, but improperly, used hindsight reasoning by relying upon Applicant's disclosure to assemble pieces from the cited Examples in an attempt to arrive at Applicants claimed invention.

In view of the foregoing, it would not have been easy to arrive at the presently claimed invention from Tasaka's Examples 5 and 6. Thus, Tasaka does not render the claims to be unpatentable.

Applicants believe that the rejection of claims 1, 3-6 and 9 under 35 U.S.C. § 103(a) has been overcome and request that the rejection be withdrawn.

B. Claims 2, 7 and 8

Claims 2, 7 and 8 are rejected as being unpatentable over Tasaka in view of Ahmed *et al.*, U.S. Patent No. 6,184,291 ("Ahmed"). Applicants respectfully traverse this grounds for rejection.

As discussed above, Applicants submit that the presently claimed invention is distinguished from Tasaka. Therefore Tasaka does not render claim 1 to be unpatentable. Applicants also submit that Ahmed fails to cure the deficiencies of Tasaka and is therefore not applicable in rendering at least claim 1 to be unpatentable. If an independent claim is nonobvious under § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988). See MPEP 2143.03. Thus, Applicants submit that claims 2, 7 and 8, each of which ultimately depends from independent claim 1, are also non-obvious at least by virtue of their dependency from claim 1.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection under § 103.

CONCLUSION

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing or a credit card payment form being unsigned, providing incorrect information resulting in a rejected credit card transaction, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. § 1.136 and authorize payment of any such extensions fees to Deposit Account No. 19-0741.

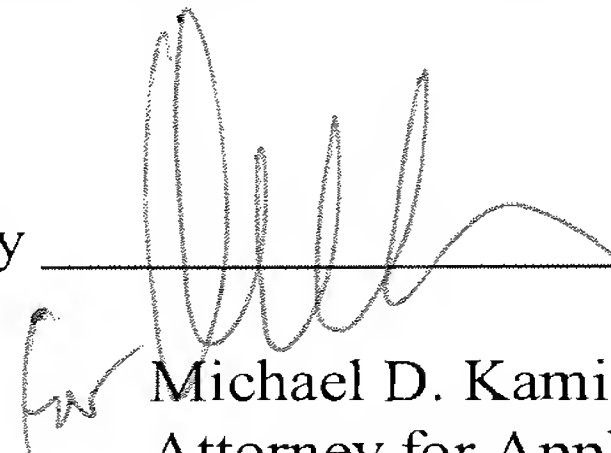
Respectfully submitted,

Date

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